

REMARKS

The Office Action of March 6, 2003 has been received and carefully reviewed. The Examiner's withdrawal of the prior art rejection, under § 102(b), of claim 1 as being anticipated by the BMW reference is greatly appreciated. In light of the above amendments to the specification and claim 7 and in view of the following remarks, further consideration of this application is now requested.

With regard to the Examiner's objection to the drawings, the schematic depictions of the swinging mechanisms for raising and lowering the covers added to the Figures 2A-2D and 3A-3C in the Submission of New Drawings of October 12, 2002 are consistent with the original disclosure. As pointed out to the Examiner previously, the specific means to produce the claimed movements is not the invention as those skilled in the art will know numerous techniques for doing so, and by way of example, the Examiner has been presented with U.S. Patent No. 4,911,496 (see Figures 2-5), U.S. Patent No. 4,911,497 (see Figures 9-12, 18-22), as well as French Patent No. 2,730,958 (see Figures 2-4) each of which disclose various specific means of cooperation between lateral guides of a roof and cam surfaces to move a front or rear edge of a roof cover out of the plane of roof and move the cover longitudinally to an open position along the guides. The instant Figures 2C and 2D clearly illustrate (using the arrows) the claim 7 cooperation of the rear roof cover and the lateral guides G set forth in claim 7. That is, Figure 2C illustrates (see arrow) that the rear edge 19 of the rear cover 15 moves at the roof plane as movement along the guide G continues. Thereafter, Figure 2D illustrates that after substantial movement along the guide G, the rear edge 19 of the rear cover 15 must be moved out of the plane of the roof (see arrow 27) to avoid contact with the rear edge 18 of the front cover 14. The specific means for effecting such movement can be via any well known means for moving an edge of a roof cover out of the plane of a roof while also enabling longitudinal movement of the cover, such as shown by with U.S. Patent No. 4,911,497

(see Figures 9-11) or as French Patent No. 2,730,958 (see Figures 2-3). This technique of illustrating the functions or means specifically claimed is sanctioned by USPTO practice, see MPEP 608.02(d) - Complete Illustration in Drawings

37 CFR 1.83 Content of drawing.

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the **drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box)**. Emphasis added

Further, the Applicants do not understand Examiners insistence on the requirement to illustrate specific means for achieving the claimed movement since the black box and line illustrations of means "G" and "S" is consistent with USPTO practice (see above) and is consistent with the Examiner's own determination that such a showing need not be made in many other applications of related technology examined by the current Examiner. For example, in U.S. Applications 09/803,435 and 09/803,371, each examined by the current Examiner and also assigned to the same assignee as the instant application, which have been issued as U.S. Patent Nos. 6,457,770 (column 3, line 10, to column 4, line 28; Figures 1-2H; claims 1 and 8) and 6,565,149 (column 3, line 10, to column 4, line 20; Figures 2A-2J; claim 1), respectively, the current Examiner correctly determined that each patent, in setting forth in general terms only the numerous upward, downward and lateral movements of the front edge of either or both a front cover and a rear cover, did not require any illustration or discussion of specific means for effecting the upward, downward or longitudinal movement of the claimed features.

The Applicant continues to assert, for the reasons above, that a specific illustration of a means for effecting the claimed movement of the front or rear cover set forth in claims 1-9 is not required or necessary to the understanding of the claimed invention and the illustrations of the claimed movements set forth in the Submission

of New Drawings of October 11, 2002 fully comply with the accepted USPTO practice prescribed by 37 C.F.R. 1.83(a).

Claims 1-9 were rejected under 35 U.S.C. § 112, first paragraph as being based on a defective written description. This rejection is based upon the assertions above that one of ordinary skill in the prior art at the time of the invention would not recognize that the Applicant had possession of the invention as claimed since no specific means are disclosed or illustrated for effecting the claimed downward and longitudinal movement of the front and/or rear covers. However, the Applicant has provided several references of record which illustrate specific means for effecting the movement (downward) of the front edges of the front and rear covers out of the plane of the vehicle roof while cooperating with lateral guides to enable longitudinal movement of the cover.

Specifically, U.S. Patent No. 4,911,497 (see Figures 9-11) and French Patent No. 2,730,958 (see Figures 2-3) each disclose various means of cooperation between lateral guides of a roof and cam surfaces to effect move a front or rear edge of a roof cover out of the plane of roof and move the cover longitudinally to an open position along the guides. While the U.S. Patent No. 4,911,497 ('497) patent has already been discussed in the record, see Amendment of October 11, 2002, the Examiner is unconvinced by the teachings of the '496 patent, discussed in the Amendment of February 12, 2003, since the roof cover of patent '496 "does not operate in the manner claimed as the rear cover 14, and while swingable into a 'tilted ventilator position' is not 'displaceable in a lengthwise direction...into an open position.'"

However, in making such a point the Examiner has misunderstood the requirements of 35 U.S.C. 112 first paragraph which require evidence that the applicant had possession of the claimed subject matter. The instant specification clearly illustrates to one of ordinary skill in the prior art that the Applicant had possession of the claimed downward movement of the front edge of the front or rear covers by pivoting about the rear edge of the cover while also permitting longitudinal

movement of the covers, just like commonly assigned related U.S. Patent Nos. 6,457,770 (see Figures 2C, 2F, 2H, 3B) and 6,565,149 (Figures 3D, 3E), at the time of the invention. What is not set forth in the instant application (and not needed in the instant application or in the disclosures of related U.S. Patent Nos. 6,457,770 and 6,565,149) is an explicit teaching of the specific means employed to effect the claimed motion since one of ordinary skill in the prior art would realize that the Applicant has many known means for effecting the claimed movements. The fact that the '496 patent does not effect the same complete operation as presently claimed, while relevant in making a determination under § 102 and/or § 103, is not a determinant factor of a proper written description. What is relevant to the consideration of § 112 (first paragraph-written description) for the instant specification is that the '496 patent (see Figures 2, 3, elements 18, 21, 22, 23, 30, 30) teaches one of ordinary skill in the prior art the well known means of effecting downward movement of front edge 34 of a roof cover 14 out of the plane of the roof by pivoting around the rear edge 49 through cooperation of a cam surface 30 and guide rails 16.

Also relevant to the consideration of § 112 (first paragraph-written description) for the instant specification is that the '497 patent (see Figures 9-12, elements 20, 27, 28, 42, 43, 58, 69, 71; Figures 18-22, elements 20, 27, 43, 69, 71) teaches one of ordinary skill in the prior art the well known means of effecting downward movement of a front edge 43 of a cover 20 out of the plane of the roof by pivoting around a rear edge 42 through cooperation of a cam surface 71 and guide rails 28 to enable longitudinal movement of the cover 20. Note, that the cover assembly of the '497 patent also does not completely operate according the manner currently claimed, but one of ordinary skill in the prior art is also taught (like the instant specification) that the rear edge 42 must also be moved out of the plane of the roof in order to effect complete opening of the roof.

Still further, it is also relevant to the consideration of § 112 (first paragraph-written description) for the instant specification is that the French Patent No.

2,730,958 ('958) patent (see Figures 2-4, elements 3, 4, 10, 11, 12a, 12b, 12, 13, 14, 15, 52) teaches one of ordinary skill in the prior art the well known means of effecting movement of an edge 4 of a front cover 10 out of the plane (upward) of the roof by pivoting around the other edge through cooperation of a cam surface 12a, 12b and lateral guide rails 3 to enable longitudinal movement of the front cover 10 (Figure 4) relative to the rear cover. Note, that the '958 patent teaches, like the instant application, that the trailing edge of the cover 10 can travel in the plane of the roof during a portion of the longitudinal movement (see Figure 3, element 12a) of the cover, but that, prior to completion of the longitudinal movement, the trailing edge of the cover must be moved (Figure 4, element 12b), like the leading edge, out of the plane of the roof to complete the longitudinal movement (and avoid contact with the trailing edge of the other cover). Note the similarity of the path of the trailing edges (Figures 2-4, element 12) and the path 27 of the trailing edge 19 of the instant invention (see Figure 2D).

The Applicant asserts that it is clearly not required (to establish the Applicant's possession of the claimed invention) that a specific means be disclosed for effecting downward movement of a front edge of a cover and longitudinal movement of a front cover and a rear cover relative to each other in order to meet the criteria § 112 (first paragraph - written description) as evidenced by the claims and disclosure of U. S. Patent Nos. 6,457,770 and 6,565,149. Further, one of ordinary skill in the prior art would realize that the Applicant would be aware (in possession) of specific means, as taught by U.S. Patent No. 4,911,496 (see Figures 2-5), U.S. Patent No. 4,911,497 (see Figures 9-12, 18-22) and French Patent No. 2,730,958 (see Figures 2-4), which are in fact well known and available for effecting the individual movements of the front and rear cover presently claimed. Therefore, withdrawal of the rejection, under criteria § 112 (first paragraph-written description), is respectfully requested.

Further, claims 1-9 were also rejected under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure. However, from the elaboration of the

teachings of U.S. Patent No. 4,911,496 (see Figures 2-5), U.S. Patent No. 4,911,497 (see Figures 9-12, 18-22) and French Patent No. 2,730,958 (see Figures 2-4) above, it can be seen that one of ordinary skill in the prior art would, without undue experimentation, be able to make and use the presently claimed invention. The exact configuration of the lateral guides, guide (cam) surfaces and pathways to effect the claimed downward movement of the front edge of a cover, the longitudinal movement of the cover and the downward movement of the rear edge prior to completion of the longitudinal movement would involve only routine experimentation once a person of ordinary skill in the prior art is made aware of the teachings of the instant specification, particularly since one of ordinary skill in the prior art would also be aware of the teachings of U.S. Patent No. 4,911,496 (see Figures 2-5), U.S. Patent No. 4,911,497 (see Figures 9-12, 18-22) and French Patent No. 2,730,958 (see Figures 2-4). Therefore, withdrawal of the rejection, under criteria § 112 (first paragraph - lack of enablement), is respectfully requested.

Finally, for the reasons elaborated upon above regarding the propriety of illustrating the lateral guides as "G" and the means for effecting downward movement as "S" in the drawing figures, the Applicants assert that the inclusion of the identifiers "G" and "S" in the specification, at paragraphs [0020] and [0023], is correct and consistent with USPTO practice of identifying illustrated features of the drawings using alpha-numerals (see 37 C.F.R. 1.84(p)(5)). Therefore, withdrawal of the objection to the specification is earnestly requested.

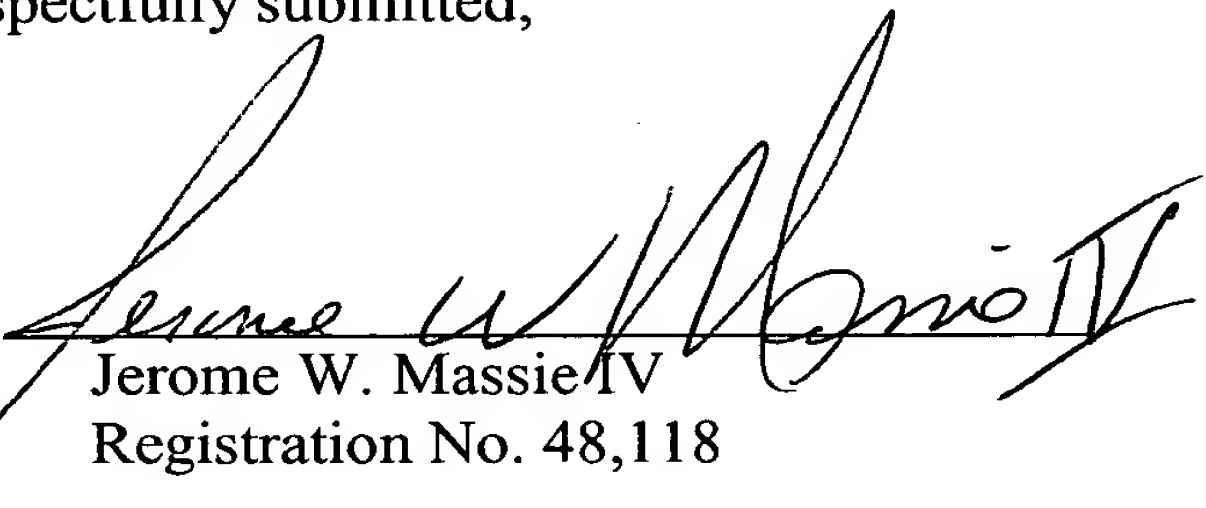
While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Lastly, it is noted that a separate Extension of Time Petition (two months) accompanies this response along with a check in payment of the requisite extension of

time fee. However, should that petition become separated from this Amendment, then this Amendment should be construed as containing such a petition. Likewise, any overage or shortage in the required payment should be applied to Deposit Account No. 19-2380 (740123-351).

Respectfully submitted,

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